REMARKS

Claims 1-2, 4-7 and 9-12 have been rejected under 35 U.S.C. § 103(a) over Jentoft (U.S. Pub. No. 20020161629, hereinafter "Jentoft") in view of Rubin, et al. (U.S. Pat. No. 6,735,624, hereinafter "Rubin"). Applicant respectfully traverses this rejection.

Claims 1 and 6 require a user to participate in an event and satisfy a "condition having some degree of difficulty" in order to acquire access to "privileged Website information." Applicant respectfully submits that these features of the present invention are neither taught nor suggested by either Jentoft, Rubin or the combination thereof.

In paragraph 4 of the Office Action, it is stated that "Jentoft does not show explicitly said user acquiring a pre-established privileged access right." However, the Examiner argues, Rubin shows this limitation, and "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify JENTOFT's functions of providing promotion information at website(s) with Rubin's portal service." Applicant respectfully disagrees.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. M.P.E.P. §2143. A motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

> [T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a

> **reason, suggestion, or motivation in the prior art** that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

(Emphasis added). Furthermore, The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.

Applicant respectfully submits that the Office Action did not carry its burden to establish a prima facie case of obviousness. The Office Action failed to clearly and particularly show reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success.

On pages 3, 5, 7 and 9 of the Office Action, it is argued that the modification of Jentoft with Rubin's portal service would have been obvious, and one skilled in the art would have been motivated to do so "to lure users to continue accessing the website for product information." Applicant respectfully disagrees.

Jentoft lured users by providing them with a personalized identification number that can be used with a machine-readable access card in order to get a cash payment. (Jentoft par. 0012). Accordingly, as Jentoft already provided a lure for his customers, Jentoft does not suggest any alternatives to his invention which would provide the user with access to "privileged Website information." In fact, such alternative would vitiate Jentoft's invention because providing users with privileged website information is a completely different website promotion model from providing users with a cash card. While Jentoft was skilled in the art of website design, Jentoft never suggested implementing access to "privileged Website information," as distinctly claimed by Applicant. For this reason, withdrawal of the rejection of dependent claims 1 and 6 on the basis of Jentoft in view of Rubin is therefore respectfully requested.

Claims 2, 4 and 5 are dependent on and include all of the limitations of base claim 1. Therefore, all of the above arguments regarding independent claim 1 apply

equally to dependent claims 2, 4 and 5. Withdrawal of the rejection of dependent claims 2, 4 and 5 on the basis of Jentoft in view of Rubin is therefore respectfully requested.

Claims 7, 9 and 10 are dependent on and include all of the limitations of base claim 6. Therefore, all of the above arguments regarding independent claim 6 apply equally to dependent claims 7, 9 and 10. Withdrawal of the rejection of dependent claims 7, 9 and 10 on the basis of Jentoft in view of Rubin is therefore respectfully requested.

Claims 11 and 12 require a user to have access to a "privileged Website information." Applicant respectfully submits that this feature of the present invention is neither taught nor suggested by either Jentoft, Rubin or the combination thereof.

The Office Action combined Rubin with Jentoft to anticipate the "privileged Website information" limitation in claims 11 and 12. As mentioned above in relation to claims 1, 2, 4-7 and 9, the Office Action failed to support its rejection of claims 11 and 12 with clear motivation to combine the cited references. For this reason, withdrawal of the rejection of dependent claims 11 and 12 on the basis of Jentoft in view of Rubin is therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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